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In re Application of:	:	
NELSON, Lloyd, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/572,994	:	37 CFR 1.47(a)
PCT No.: PCT/US02/12961	:	
International Filing Date: 25 April 2002	:	
Priority Date: 27 April 2001	:	
Atty's Docket No.: ARZ-024630-WO	:	
For: POLYBASIC ACID ESTERS AND	:	
THEIR USE IN CABLES	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a) For Filing When Inventors Refuse To Sign Or Can Not Be Found" filed 08 November 2006. Deposit Account No. 09-0525 will be charged the required petition fee.

BACKGROUND

On 25 April 2002, applicants filed international application PCT/US02/12961. The international application claimed a priority date of 27 April 2001, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 27 October 2003.

Applicants did not enter the U.S. national stage prior to the expiration of the thirty-month deadline. Accordingly, the application became abandoned with respect to the United States at midnight on 27 October 2003.

On 23 March 2006, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a petition for revival of the application under 37 CFR 1.137(b).

On 21 April 2006, this Office mailed a decision granting applicants' petition for revival under 37 CFR 1.137(b).

On 10 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and \$1410 in additional claims fees were required.

On 08 November 2006, applicants filed a response to the Notification Of Missing Requirements (with the authorization to charge Deposit Account No. 09-0525 the required four-month extension fee). The response included the authorization to charge Deposit Account No. 09-0525 for the required surcharge and claims fees. The response also included a declaration executed by one of the two inventors and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of the second inventor Nancy B. MOSBY, whom applicants assert has refused to execute the application.

On 11 December 2006, applicants filed a request for a five-month extension of time to respond. Based on this submission, Deposit Account No. 09-0525 was charged \$2,160. Because the response filed herein on 08 November 2006 only required a four-month extension of time, the additional extension fee paid for the fifth month will be refunded to the Deposit Account.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here authorized a charge to Deposit Account No. 09-0525 for the required petition fee, and the petition states that the contact information listed on the accompanying declaration is the last known information for the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by co-inventor Lloyd A. NELSON and including an unsigned signature block for the non-signing inventor, Nancy D. MOSBY. This declaration can be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application

papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor's refusal to execute the declaration, applicants have provided a letter from the inventor dated 23 April 2002. In that letter, the inventor refers to an invention developed by herself and Lloyd Nelson and states that she does not "desire any credit or recognition in relation to this patent, nor do I desire to retain any potential benefits now or in the future associated with this patent." The inventor goes on to state that "[i]f you must contact me for anything further, you can direct a letter to me at the address listed above."

The inventor's four-year old letter, on its own, is not sufficient to support the conclusion that the inventor refuses to execute the declaration in the present application (for example, it is not clear from the face of the letter whether it refers to the invention underlying the present application). Before it can be concluded that the inventor refuse to execute the declaration herein, applicants are required to send a copy of the complete application (specification, claims, and drawings) to the last known address of the inventor, accompanied by a request that the inventor either execute the declaration or expressly confirm her refusal to execute the declaration in this specific application. If the inventor's address is no longer current, applicants are required to provide evidence that a diligent effort has been made to locate a current address for the inventor and contact her at such address (such a diligent effort should include, but not be limited to, an internet search). As noted in the MPEP, a firsthand statement confirming the asserted facts, with available documentary support, should accompany any submission relating to additional efforts made to obtain the inventor's signature (e.g., copies of the cover letter sent to the inventor, confirmation of receipt of such letter, copies of internet search results, etc.).

Until adequate supplemental materials are provided to confirm that the inventor refuses to execute the declaration herein or cannot be located after diligent effort, item (4) is not satisfied.

Finally, it is noted that, when a charge was attempted by the USPTO, Deposit Account No. 09-0525 did not include sufficient funds for all required fees. Accordingly, the Deposit Account will be charged the \$1,590 four-month extension fee, the \$200 petition fee, and the \$130 surcharge for filing the declaration later than thirty months after the priority date. Applicants are still required to submit payment of the \$1,410 in outstanding claims fees, as set forth in the Notification Of Missing Requirements.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above. No additional petition fee is required.

Any response to the present decision must also include payment of the outstanding claims fees required by the Notification Of Missing Requirements mailed 10 May 2006.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents
of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'rll n', located below the typed name.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459